

REMARKS

In numbered paragraph 2 of the Official Action, there is a Rule 105 request, because of the conclusion by the Examiner that an issue of public use or on sale activity has been raised in this application.

No issue of public use or on sale activity has been raised in this application.

In the Declaration under Rule 132, paragraph number 20, it has been stated that "...this laminated shingle of CertainTeed [those made in accordance with this patent application]...has been commercially sold for less than 4 years. That Declaration was dated August 17, 2007. Four years earlier than August 17, 2007 is August 17, 2003. August 17, 2003 is about 7 months earlier than the March 23, 2004 effective filing date of this application. For the invention of this patent application to have been in public use or on sale more than one year prior to the date of the application for patent, so as to raise an issue of public use or on sale, such activity would have had to occur prior to March 23, 2003, **not** after August 17, 2003. Accordingly, there is no issue of public use or on sale activity, and the facts supporting that there has been no such public use or on sale activity is already sworn to in the Declaration of Richard Allan Snyder dated August 17, 2007, of record in this case. Notwithstanding that fact, the closest actual date of when the method product was first commercially sold, is stated in the Declaration of Robert L. Jenkins provided herewith, as being mid-June, 2004, which is well after the March 23, 2004 filing date of this application.

Accordingly, while no issue of public use or on sale activity has been raised in this application, applicant nevertheless provides the date requested by the Examiner.

In numbered paragraph 5 of the Official Action of September 21, 2007, it is incorrectly stated that the goal of applicants as expressed on page 2 paragraph 4 is the same as the goal of Koschitzky as expressed in column 5 lines 4-18.

The goal of applicants as can be seen from page 2 paragraph 4, is to remove the intermediate areas to yield sharply defined tabs, not to remove "part of the transition area" to provide whatever degree of "sharp visual demarcation" is provided by such partial removal of intermediate areas as the Koschitzky reference cites in column 5 lines 4-18.

The statement in numbered paragraph 5 of the Official Action of September 21, 2007 that in Koschitzky, column 5 lines 34-38 that "The portions 36A, 36B of the transition area which remain after the slot has been cut will not be noticed by the eye, because of the presence of the slot 76" is wrong, and Koschitzky itself shows in Fig. 7 that regions 36A and 36B of Fig. 7 are clearly noticeable as is shown by the hatch marks on each side of the slot. See Fig. 7, reproduced below, where it is clear that the slot 76 occupies only one third of the transition area, and that an additional two thirds of the transition area is occupied by the remaining portions of the transition area.

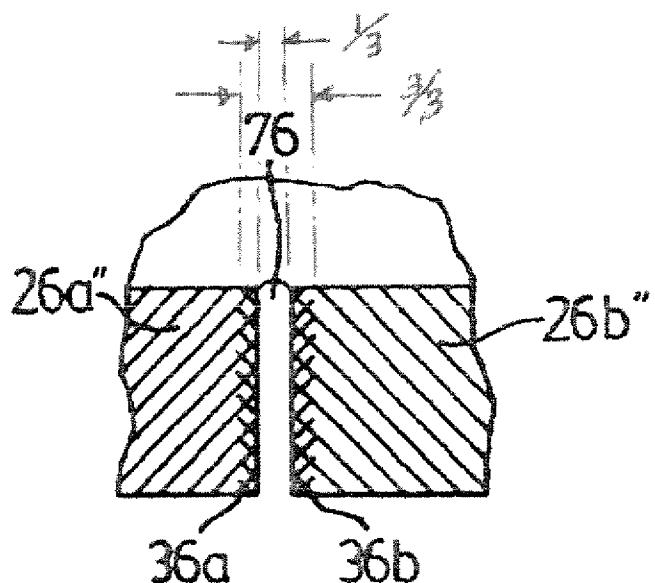


FIG. 7

The same is true in the reproduced portion of Fig. 6, where the slot 36 clearly shows hatched portions of the transition area between adjacent tabs that are not removed.

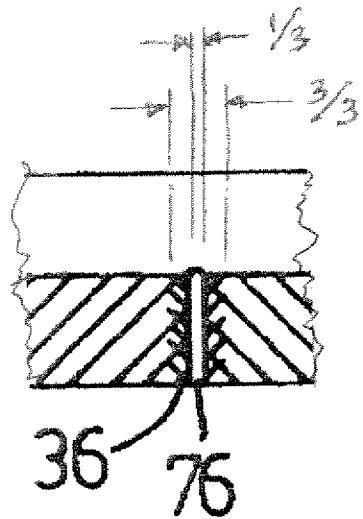


FIG 6.

While numbered paragraph 5 of the Official Action goes on, on page 4, to state that "Column 5, line 4+ states slots 76 are located in all or substantially all of the transition areas 36 between adjacent colored areas", that merely states that there is a slot in each transition area; it does **not** state that all of any transition area is removed.

Similarly, in numbered paragraph 5 on page 4, where reference is made to column 7 lines 3-9 for a teaching that slots may vary in width and appearance, nowhere at all in the reference is it stated that any such slot completely removes any transition area. Rather, it is clear from all of the available text and all of the pertinent figures of Koschitzky, that **substantial** portions of each transition area remains present in tabs on each side of the slots; in fact, as mentioned above, it is shown that the transition areas in Figs. 6 and 7, where slots are removed, that only one third of the transition area is removed by the slot, and that two thirds of the transition area in each case appear, with about one third of each transition area being on each side of the slot, and with the hatch marks that represent the retained transition areas being clearly visible to the eye.

In the Official Action of September 21, 1007, numbered paragraph 5 goes on, on page 4, to state the Examiner's position that the Koschitzky reference "provides at least the suggestion for complete removal when conditions so necessitate". That statement is at odds with the text and illustrations of Koschitzky. There is no reference whatever in

Koschitzky to such complete removal, and such statement is therefore without factual support in Koschitzky.

In fact, that statement is in stark contrast to the many (at least 8 times as addressed on pages 4, 5 of Applicants' amendment remarks filed August 24, 2007, where a collection of such statements of Koschitzky are presented, to the contrary.

In numbered paragraph 5 on page 4 of the Official Action, it is stated that

There is no evidence presented by Applicants that completely removing the intermediate [transition areas] across its width provides any mechanical or other advantage not cited by the reference.

Paragraph 4 of the Snyder Declaration of record in this case sets forth at least 5 mechanical and functional effects and advantages that are accomplished by complete removal as referenced in the identified claims, and such, being in a sworn Declaration, **is evidence** as to mechanical and functional effects and advantages of the present invention.

At the top of page 8, it is stated in the Official Action that paragraph 14 of the Declaration is "simply erroneous". It is not erroneous. While a preferred portion is described in detail in Koschitzky, as being removed, and whether that amount is precisely where the distribution of granules is a 50:50 distribution or slightly more or slightly less, such must be read in the total context of Koschitzky, which Koschitzky describes at least 8 times and shows in Figs. 6 and 7, **that there remains in each case some portion** of the transition area on each side of the slot.

As such, Koschitzky teaches away from complete removal of the transition areas.

On page 8 line 5 of the Official Action, Mr. Snyder's opinion is mis-cited. It is stated that Mr. Snyder testifies that the claims are not obvious because they are not "expressly" taught in the prior art, in numbered paragraph 21. Mr. Snyder's statement is not limited to "expressly"; he states that Koschitzky and the other art does not teach the present invention and that the invention is not obvious. Thus, Mr. Snyder's Declaration is not so limited. It can only be fairly read to state that Koschitzky and the other art does not expressly teach the present invention, and does not teach the present invention in any other manner, such as on the basis of obviousness.

While the Examiner states on page 8 that Koschitzky did envision the removal of any offensive amount of overlap, again, every expression of Koschitzky was to the contrary, be it in text, or in illustrations.

Nowhere in Koschitzky was there any suggestion whatever of a **complete** removal of transition areas.

It is noted that in the Official Action, the Examiner continues to rely upon *In re Seid*. Again, it is submitted that *In re Seid* was not a case decided based upon the 1952 Patent Act. Rather, it was decided in 1947. Nowhere since 1947 does there appear any citation of *In re Seid* for the proposition advanced by the Examiner; namely to the effect that matters related to ornamentation or aesthetic effect cannot be the basis of patentability. While *In re Seid* is cited for other propositions, it is cited nowhere for this proposition. And in fact, as is addressed in numbered paragraph 3 of the previous response of applicants in this matter, while *In re Seid* is mentioned in MPEP §2144.04, it is immediately followed by a reference to *In re Dembiczik*, a much more recent citation of the Federal Circuit, which supported patentability being predicated upon aesthetic or ornamental effects in a utility patent.

In numbered paragraph 12 of the Snyder Declaration of record, over 50 patents are referenced where aesthetic or ornamental aspects of shingles routinely form the basis for patentability, and have been for the last 30 years. The Examiner dismisses those as forming unexpected appearances and therefore being unobvious, and would seek to distinguish them from the instant application, as not being relevant to the instant case, because the Examiner remains of the opinion that the difference between the claims of the instant application and Koschitzky are obvious. One of the things that such accumulation of patents in numbered paragraph 12 establishes, is that *In re Seid* is not law that is currently being applied by the U.S. Patent Office, particularly in the shingle or roofing art. Such accumulation of patents in this art predicated on ornamentation and aesthetics belies any current viability to *In re Seid*.

As to the non-obviousness of modifying Koschitzky as the Examiner would, notwithstanding the many text and illustrative references in Koschitzky to the contrary, such is amply addressed above and will not be repeated here.

It is also noted that the Examiner cites the recently decided U.S. Supreme Court case *KSR International Co. v. Teleflex Inc. et al* 82 U.S.P.Q. 2d 1396, specifically on

page 6 of the Official Action, for the proposition that that case forecloses "the argument that a specific teaching, suggestion or motivation is required to establish a *prima facie* case of obviousness". But applicant here does not argue that a specific teaching must be provided by the Examiner of making the modification that the Examiner would have to make to Koschitzky. Rather, applicant here argues that Koschitzky itself leads away from the teaching of complete removal of the transitional areas. Moreover, in the *KSR* case, the U.S. Supreme Court also cited *Graham v. John Deere Co.* 383 U.S. 1, 15 Led 2d 545, 86 SC 684 for the proposition that the fact finder should "guard against slipping into use of hindsight"...and should..." resist the temptation to read into the prior art the teachings of the invention in issue." It is submitted that this admonition from *Graham v. Deere* that is reinforced by the Supreme Court in the *KSR* decision is quite applicable here, and that the Examiner should resist reading into Koschitzky that which is taught by the Applicants in the instant application, especially where Koschitzky goes to such great lengths throughout its text and illustrations, to retain on each side of the slot, portions of the transition areas, and where Koschitzky in fact teaches the retention of two thirds of such transition areas.

Toward the bottom of page 8 of the Official Action, the Examiner finds that the sworn facts relating to rapid commercial success, as are present in paragraph 20 of the Snyder Declaration are inadequate, raising the question of whether there were other considerations such as promotion, advertising, or market share that dictated such commercial success. But the evidence of commercial success is present in paragraph 20, and that is the evidence of the same that is before the Examiner. Merely suggesting theoretical other factors not known to have any relevance to the commercial success achieved by this invention, and merely raised in argument, does not denigrate the commercial success established by Article 20. Nevertheless, in the Declaration of Mr. Jenkins provided herewith, it is established that other such factors were not relevant to the commercial success that is achieved by the present invention, because the factors of promotion, advertising and other marketing conditions for the commercialization of shingles of this invention were essentially the same as those factors for the other commercially successful CertainTeed shingles to which it is compared in paragraph 20 of the Snyder Declaration.

In numbered paragraph 6 on page 5 of the Official Action, the Examiner rejects claims 8 through 10 as being unpatentable over Koschitzky in view of the admitted prior art. Applicant herewith repeats by reference, the comments raised in the response to the previous Official Action related thereto, as essentially traversing that rejection as well, for all of the reasons set forth above with respect to the rejection over the reference Koschitzky alone, because none of those other references suggest or teach in any way, the deficiencies of Koschitzky as are addressed herein above.

For all of the above reasons, reconsideration and allowance of all of the claims of this application are respectfully submitted.